

Remarks:

These remarks are responsive to the final Office action dated September 20, 2005. Prior to the entry of this amendment, claims 1-32 remained pending in the application. Claims 1, 4, 6-9, 12, 14, 15-17, 20, 22-25, 28, and 30-32 stand rejected under 35 U.S.C. § 102(b) based on Salgado (US 5,579,087). Claims 2, 10, 18, and 26 stand rejected based on Salgado in view of Kanerva et al. (US 6,026,416). Claims 3, 5, 11, 13, 19, 20, 27, and 29 stand rejected based on Salgado in view of Hicks et al. (US 5,481,353). Applicant respectfully traverses the rejections for at least the reasons set forth below.

Rejection of Claims 1-8

In the present Office action, claims 1, 4, and 6-8 are rejected under 35 U.S.C. § 102(b) over Salgado (US 5,579,087). Claim 2 stands rejected based on Salgado in view of Kanerva et al. (US 6,026,416). Claims 3 and 5 stand rejected based on Salgado in view of Hicks et al. (US 5,481,353).

The Examiner asserts that Salgado discloses the method recited by claim 1. Claim 1 recites, in part, a method including "specifying a set of individual packaging characteristics with respect to each of the files; and responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics... corresponding to each of the files."

In the specification of the present application, applicant identifies several packaging characteristics, including, "(a) individual ones of the files that are not included in a general distribution package; (b) one or more options (e.g., stapling, collating, etc.) to identify how at least one subset of the files are packaged; (c) how

many copies to print with respect to particular ones of the files that are for general audience distribution; and/or (d) how many copies to print with respect to particular ones of the files that are independent of other files that are for general audience distribution." (Specification page 3, lines 10-15)

Salgado relates to the construction of a multi-segment print job from multiple local or remote sources using a network interface. Applicant notes that the segments taught by Salgado may correspond to the files of the present application, and that the print job taught by Salgado may correspond to the presentation profile of the present application. Specifically, Salgado teaches that a print job is composed from multiple image segments that are scattered over a network. Each segment may have a different format, and may be saved in any location on the network. The print job may be output to one or more printers with selectable features or attributes of the required job.

However, Salgado fails to teach, disclose, or suggest specifying a set of individual packaging characteristics for each of the segments, or files, as recited in claim 1 of the present application. Specifically, Salgado teaches, "The operator then specifies the job programming for the job: quantity=10, finishing=bind ...collation=TRUE." (Salgado column 6, line 9-10) Accordingly, "quantity," "finishing," and "collation" are specified for the entire job, and not for individual segments or files. Therefore, Salgado fails to disclose or suggest "printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics ... corresponding to each of the files."

Since Salgado fails to disclose every element of claim 1, applicant submits that claim 1 is allowable, and requests the withdrawal of the rejection of claim 1

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under 35 U.S.C. § 102(b) over Salgado. Furthermore, since claims 4 and 6-8 depend from claim 1, applicant asserts that these claims are allowable for at least the same reasons as claim 1.

In particular, with respect to claims 4 and 6, Salgado fails to anticipate under 35 U.S.C. § 102(b). Claim 4 recites, in part, a method including "selecting one or more options to identify how at least one subset of the files of the presentation package are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of files." Claim 6 recites, in part, a method including "indicating a number of copies to print with respect to a subset of the files that are to be included in the presentation package." As discussed above in reference to claim 1, Salgado fails to disclose the specification of individual packaging characteristics of each segment, or subsets of segments, as recited specifically in claims 4 and 6.

Claim 2 has been rejected under 35 U.S.C. § 103(a), as being unpatentable over Salgado in view of Kanerva et al. Claim 2 recites the method of claim 1, "wherein a first subset of the files were generated using a first computer program application, and wherein a second subset of the files were generated using a second computer program application that is different than the first computer program application." The Examiner has acknowledged that Salgado fails to disclose the generation of a first subset of files using a first computer program application and the generation of a second subset of files using a second computer program application. The Examiner thus refers to Kanerva et al.

Kanerva et al. relates to a system and method for storing, viewing, editing and processing ordered sections of a binder document wherein the sections have

different native file formats. Selected sections of the binder document can be printed as a single consecutively printed document without other print jobs interrupting or intervening between printed sections. However, as argued in response to a previous Office action, Kanerva et al. fails to teach, disclose, or suggest specifying a set of individual packaging characteristics for each of the files, as recited in claim 1 (from which claim 2 depends). Accordingly, Salgado and Kanerva et al., taken either alone or in combination, fail to disclose every element of claim 2. Applicant submits that claim 2 is therefore allowable and requests withdrawal of the rejection of claim 2 under 35 U.S.C. § 103(a). Furthermore, since claim 2 depends from claim 1, this claim is allowable for at least the same reasons as claim 1.

Claims 3 and 5 have been rejected under 35 U.S.C. § 103(a), as also being unpatentable over Salgado in view of Hicks et al. Claim 3 recites the method of claim 1, "wherein specifying the packaging characteristics further comprises: identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files." Claim 5 recites the method of claim 1, "wherein specifying the packaging characteristics further comprises: identifying a subset of files that are to be included in a general distribution package; and indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package." The Examiner has acknowledged that Salgado fails to disclose the identification of subsets of files to be included in a presentation package or a general distribution package, nor the indication of a number of copies to print

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with respect the subset of files that are to be included in the presentation package. The Examiner thus refers to Hicks et al.

Hicks et al. relates to an apparatus for producing variable feature presentation sets. These variable feature presentation sets are created by modifying an original document and then adding other elements, on a page-by-page basis. The Examiner asserts that Hicks et al. discloses the identification of subsets of files to be included in a presentation package or a general distribution package, and the indication of a number of copies to print with respect the subset of files that are to be included in the presentation package. However, as noted in response to a previous Office action, applicant disagrees that the variable feature presentation sets of Hicks et al. are analogous to the subsets of files to be included in a presentation package or a general distribution package of the present application. Moreover, applicant asserts that, Hicks et al. fails to teach, disclose, or suggest specifying a set of individual packaging characteristics for each of the files, as recited in claim 1 (from which claims 3 and 5 depend).

Specifically, Hicks et al. teaches that "job portions (such as handout and master sets) can be stapled together (by a stapler, not shown) to generate the desired multiple stapled job portions." Hicks et al., therefore teaches that the packaging characteristics taught by applicant in the present application may be specified for the handout and master sets, which may be analogous to the presentation package or general distribution package of the present application, and not for individual component files of these packages. Applicant asserts that the Examiner has failed to establish prima facie obviousness of claims 3 and 5. Claims

3 and 5 are therefore allowable, and the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn.

Rejection of Claims 9-16

In the present Office action, claims 9, 12, and 14-16 are rejected under 35 U.S.C. § 102(b) over Salgado (US 5,579,087). Claim 10 stands rejected based on Salgado in view of Kanerva et al. (US 6,026,416). Claims 11 and 13 stand rejected based on Salgado in view of Hicks et al. (US 5,481,353).

The Examiner asserts that Salgado discloses the computer-readable medium recited by claim 9. Claim 9 recites, in part, a computer-readable medium including computer-executable instructions for "specifying a set of individual packaging characteristics with respect to each of the files; and responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics... corresponding to each of the files."

As discussed above with reference to claim 1, Salgado fails to teach, disclose, or suggest specifying a set of individual packaging characteristics for each of the files, as recited in claim 9. Salgado instead focuses on the construction of a multi-segment print job from multiple local or remote sources using a network interface. There is not even any discussion of the potential for different packaging characteristics between the various segments of the print job. Salgado thus fails to disclose every element of claim 9, and the rejection of claim 9 under 35 U.S.C. § 102(b) based on Salgado should be withdrawn. Furthermore, since claims 12, 14, 15 and 16 depend from claim 9, these claims are allowable for at least the same reasons as claim 9.

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In particular, claim 12 recites, in part, "selecting one or more options to identify how at least one subset of the files of the presentation package are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of files." Claim 14 recites, in part, "indicating a number of copies to print with respect to at least a first subset of the files that are independent of at least a second subset of the files that are to be included in the presentation package."

As noted above, Salgado relates to the construction of a multi-segment print job from multiple local or remote sources using a network interface. However, Salgado does not disclose the specification of individual packaging characteristics of each segment, or subsets of segments, as recited specifically in claims 12 and 14. Therefore, Salgado fails to teach, disclose, or suggest every element of claims 12 and 14.

Claim 10 has been rejected under 35 U.S.C. § 103(a) as also being unpatentable over Salgado in view of Kanerva et al. Claim 10 recites, in part, "wherein a first subset of the files were generated using a first computer program application, and wherein a second subset of the files were generated using a second computer program application that is different than the first computer program application." The Examiner has acknowledged that Salgado fails to disclose the generation of a first subset of files using a first computer program application and the generation of a second subset of files using a second computer program application, and thus refers to Kanerva et al.

As noted above, Kanerva et al. relates to a system and method for storing, viewing, editing and processing ordered sections of a binder document wherein the

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sections have different native file formats. Selected sections of the binder document can be printed as a single consecutively printed document without other print jobs interrupting or intervening between printed sections. However, Kanerva et al. fails to teach, disclose, or suggest specifying a set of individual packaging characteristics for each of the files, as recited in claim 9 (from which claim 10 depends). Accordingly, Salgado and Kanerva et al., taken either alone or in combination, fail to disclose every element of claim 10. Applicant submits that claim 10 is therefore allowable and requests the withdrawal of the rejection of claim 10 under 35 U.S.C. § 103(a).

Claims 11 and 13 have been rejected under 35 U.S.C. § 103(a) as also being unpatentable over Salgado in view of Hicks et al. Claim 11 recites the computer readable medium of claim 9, "wherein the instructions for specifying the packaging characteristics further comprising instructions for: identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files." Claim 13 recites the computer readable medium of claim 9, "wherein the instructions for specifying the packaging characteristics further comprising instructions for: identifying a subset of files that are to be included in a general distribution package; and indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package." The Examiner has acknowledged that Salgado fails to disclose the identification of subsets of files to be included in a presentation package or a general distribution package, nor the indication of a number of copies to print with respect the subset of files that are to be included in the presentation package, and thus refers to Hicks et al.

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As noted above, Hicks et al. relates to an apparatus for producing variable feature presentation sets. These variable feature presentation sets are created by modifying an original document and then adding other elements, on a page-by-page basis. The Examiner asserts that Hicks et al. discloses the identification of subsets of files to be included in a presentation package or a general distribution package, and the indication of a number of copies to print with respect to the subset of files that are to be included in the presentation package. However, Hicks et al. fails to teach, disclose, or suggest specifying a set of individual packaging characteristics for each of the files, as recited in claim 9 (from which claims 11 and 13 depend). Accordingly, Salgado and Hicks et al., taken either alone or in combination, fail to disclose every element of claims 11 and 13. Applicant submits that claims 11 and 13 are therefore allowable and requests the withdrawal of the rejection of claims 11 and 13 under 35 U.S.C. § 103(a).

Rejection of Claims 17-24

In the present Office action, claims 17, 20, and 22-24 are rejected under 35 U.S.C. § 102(b) over Salgado (US 5,579,087). Claim 18 stands rejected based on Salgado in view of Kanerva et al. (US 6,026,416). Claims 19 and 21 stand rejected based on Salgado in view of Hicks et al. (US 5,481,353).

The Examiner asserts that Salgado discloses the computer-readable medium recited by claim 17. Claim 17 recites, in part, a computing device including computer-executable instructions for "specifying a set of individual packaging characteristics with respect to each of the files; and responsive to a single print request, printing a presentation package including each of the files in the

presentation profile based on the individual packaging characteristics... corresponding to each of the files."

As discussed above with reference to claim 1, Salgado fails to teach, disclose, or suggest specifying a set of individual packaging characteristics for each of the files, as recited in claim 17. Salgado instead focuses on the construction of a multi-segment print job from multiple local or remote sources using a network interface. There is not even any discussion of the potential for different packaging characteristics between the various segments of the print job. Salgado thus fails to disclose every element of claim 17, and the rejection of claim 17 under 35 U.S.C. § 102(b) over Salgado should be withdrawn. Furthermore, since claims 20 and 22-24 depend from claim 17, these claims are allowable for at least the same reasons as claim 17.

Claims 20 and 22 have been rejected under 35 U.S.C. § 102(b) as also being unpatentable over Salgado. Claim 20 recites, in part, "selecting one or more options to identify how at least one subset of the files of the presentation package are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of files." Claim 22 recites, in part, "indicating a number of copies to print with respect to at least a first subset of the files that are independent of at least a second subset of the files that are to be included in the presentation package."

As noted above, Salgado relates to the construction of a multi-segment print job from multiple local or remote sources using a network interface. However, Salgado does not disclose the specification of individual packaging characteristics of each segment, or subsets of segments, as recited specifically in claims 20 and 22.

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Therefore, Salgado fails to teach, disclose, or suggest every element of claims 20 and 22. Claims 20 and 22 are therefore allowable for at least these reasons. Furthermore, since claims 20 and 22 depend from claim 17, these claims are allowable for at least the same reasons as claim 17. The rejection of these claims under 35 U.S.C. § 102(b) thus must be withdrawn.

Claim 18 has been rejected under 35 U.S.C. § 103(a) as also being unpatentable over Salgado in view of Kanerva et al. Claim 18 recites, in part, "wherein a first subset of the files were generated using a first computer program application, and wherein a second subset of the files were generated using a second computer program application that is different than the first computer program application." The Examiner has acknowledged that Salgado fails to disclose the generation of a first subset of files using a first computer program application and the generation of a second subset of files using a second computer program application, and thus refers to Kanerva et al.

As noted above, Kanerva et al. relates to a system and method for storing, viewing, editing and processing ordered sections of a binder document wherein the sections have different native file formats. Selected sections of the binder document can be printed as a single consecutively printed document without other print jobs interrupting or intervening between printed sections. However, Kanerva et al. fails to teach, disclose, or suggest specifying a set of individual packaging characteristics for each of the files, as recited in claims 17 and 18, and which the applicant argued above are also not taught by Salgado. Accordingly, Salgado and Kanerva et al., taken either alone or in combination, fail to disclose every element of claim 18.

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Applicant submits that claim 18 is therefore allowable and requests the withdrawal of the rejection of claim 18 under 35 U.S.C. § 103(a).

Claims 19 and 21 have been rejected under 35 U.S.C. § 103(a) as also being unpatentable over Salgado in view of Hicks et al. Claim 19 recites the computing device of claim 17, "wherein the instructions for specifying the packaging characteristics further comprising instructions for: identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files." Claim 21 recites the computing device of claim 17, "wherein the instructions for specifying the packaging characteristics further comprising instructions for: identifying a subset of files that are to be included in a general distribution package; and indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package." The Examiner has acknowledged that Salgado fails to disclose the identification of subsets of files to be included in a presentation package or a general distribution package, nor the indication of a number of copies to print with respect the subset of files that are to be included in the presentation package, and thus refers to Hicks et al.

As noted above, Hicks et al. relates to an apparatus for producing variable feature presentation sets. These variable feature presentation sets are created by modifying an original document and then adding other elements, on a page-by-page basis. The Examiner asserts that Hicks et al. discloses the identification of subsets of files to be included in a presentation package or a general distribution package, and the indication of a number of copies to print with respect the subset of files that

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are to be included in the presentation package. However, Hicks et al. fails to teach, disclose, or suggest specifying a set of individual packaging characteristics for each of the files, as recited in claim 17 (from which claims 19 and 21 depend). Accordingly, Salgado and Hicks et al., taken either alone or in combination, fail to disclose every element of claims 19 and 21. Applicant submits that claims 19 and 21 are therefore allowable and requests the withdrawal of the rejection of claims 19 and 21 under 35 U.S.C. § 103(a).

Rejection of Claims 25-32

In the present Office action, claims 25, 28, and 30-32 are rejected under 35 U.S.C. § 102(b) over Salgado (US 5,579,087). Claim 26 stands rejected based on Salgado in view of Kanerva et al. (US 6,026,416). Claims 27 and 29 stand rejected based on Salgado in view of Hicks et al. (US 5,481,353).

The Examiner asserts that Salgado discloses the user interface recited by claim 25. Claim 25 recites, in part, a user interface including "a second area for specifying a set of individual packaging characteristics with respect to Individual each of the files... and a fourth area for printing a presentation package including each of the files in the presentation profile in response to a single print request, the printing being based on the individual packaging characteristics... corresponding to each of the files."

As discussed above with reference to claim 1, Salgado fails to teach, disclose, or suggest specifying a set of individual packaging characteristics for each of the files, as recited in claim 25. Salgado instead focuses on the construction of a multi-segment print job from multiple local or remote sources using a network interface. There is not even any discussion of the potential for different packaging

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characteristics between the various segments of the print job. Salgado thus fails to disclose every element of claim 25, and the rejection of claim 25 under 35 U.S.C. § 102(b) over Salgado should be withdrawn. Furthermore, since claims 28 and 30-32 depend from claim 25, these claims are allowable for at least the same reasons as claim 25.

Claim 28 recites, in part, an area for "selecting one or more options to identify how at least one subset of the files of the presentation package are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of files." Claim 30 recites, in part, an area for "indicating a number of copies to print with respect to at least a first subset of the files that are to be included in the presentation package."

As noted above, Salgado relates to the construction of a multi-segment print job from multiple local or remote sources using a network interface. However, Salgado does not disclose the specification of individual packaging characteristics of each segment, or subsets of segments, as recited specifically in claims 28 and 30. Therefore, Salgado fails to teach, disclose, or suggest every element of claims 28 and 30.

Claim 26 has been rejected under 35 U.S.C. § 103(a) as also being unpatentable over Salgado in view of Kanerva et al. Claim 26 recites, in part, "wherein a first subset of the files were generated using a first computer program application, and wherein a second subset of the files were generated using a second computer program application that is different than the first computer program application." The Examiner has acknowledged that Salgado fails to disclose the generation of a first subset of files using a first computer program application and the

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generation of a second subset of files using a second computer program application, and thus refers to Kanerva et al.

As noted above, Kanerva et al. relates to a system and method for storing, viewing, editing and processing ordered sections of a binder document wherein the sections have different native file formats. Selected sections of the binder document can be printed as a single consecutively printed document without other print jobs interrupting or intervening between printed sections. However, Kanerva et al. fails to teach, disclose, or suggest specifying a set of individual packaging characteristics for each of the files, as recited in claims 25 and 26. Accordingly, Salgado and Kanerva et al., taken either alone or in combination, fail to disclose every element of claim 26. Applicant submits that claim 26 is therefore allowable and requests the withdrawal of the rejection of claim 26 under 35 U.S.C. § 103(a).

Claims 27 and 29 have been rejected under 35 U.S.C. § 103(a) as also being unpatentable over Salgado in view of Hicks et al. Claim 27 recites the user interface of claim 25, "wherein the second area for specifying the packaging characteristics further comprises: a fifth area for identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files." Claim 29 recites the user interface of claim 25, "wherein the second area for specifying the packaging characteristics further comprises: a fifth area for identifying a subset of files that are to be included in a general distribution package and indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package." The Examiner has acknowledged that Salgado fails to disclose the identification of

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subsets of files to be included in a presentation package or a general distribution package, nor the indication of a number of copies to print with respect the subset of files that are to be included in the presentation package, and thus refers to Hicks et al.

As noted above, Hicks et al. relates to an apparatus for producing variable feature presentation sets. These variable feature presentation sets are created by modifying an original document and then adding other elements, on a page-by-page basis. The Examiner asserts that Hicks et al. discloses the identification of subsets of files to be included in a presentation package or a general distribution package, and the indication of a number of copies to print with respect the subset of files that are to be included in the presentation package. However, Hicks et al. fails to teach, disclose, or suggest specifying a set of individual packaging characteristics for each of the files, as recited in claim 25 (from which claims 27 and 29 depend). Accordingly, Salgado and Hicks et al., taken either alone or in combination, fail to disclose every element of claims 27 and 29. Applicant submits that claims 27 and 29 are therefore allowable and requests the withdrawal of the rejection of claims 27 and 29 under 35 U.S.C. § 103(a).

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Conclusion

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

KOLISCH HARTWELL, P.C.



Walter W. Karnstein
Registration No. 35,565
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679
Attorney for Applicant

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner M. Milia, Group Art Unit 2622, Assistant Commissioner for Patents, at facsimile number (571) 273-8300 on November 21, 2005.



Christie A. Doolittle

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